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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/098,997	06/17/1998	CARLOS GONZALEZ OCHOA	VALENZ-98-27	4745

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EXAMINER	
BROWN, RUEBEN M	

ART UNIT	PAPER NUMBER
2611	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/098,997	Applicant(s) OCHOA, CARLOS GONZALEZ	
	Examiner Reuben M. Brown	Art Unit 2611	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ they raise the issue of new matter (see Note below);
   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: *See Continuation Sheet*.
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See enclosed Advisory Action*.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *17,22 and 28-39*.
   Claim(s) withdrawn from consideration: _____.
8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The proposed amendments to claims 17, 22, 30 & 37, of a "standard video", narrow the claims, raise new issues, which would require further search and/or consideration.

CHRIS GRANT
PRIMARY EXAMINER

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/22/2004 have been fully considered but they are not persuasive. Examiner respectfully disagrees with applicant's arguments that the Final Rejection mailed 2/20/2004 was premature. Applicant argues on page 3 that the amendments to claims 17 & 30, filed 10/6/2003, represents subject matter already included in claim 22. Applicant argues that the claims 17 & 30 were amended on 10/6/2003, "to make specific the fact that list of permitted video channels transmitted from the head end to a remote module within a scan line. However this requirement has always been a part of calm 22, which recited this limitation when it was originally filed.". Examiner agrees with applicant that this feature was included in claim 22, nevertheless its addition to claims 17 & 30 changed the scope of those claims, and therefore a final office was justified. Furthermore, examiner points out that claims 17 & 30 add a substantial other additional features, which also change the scope of those claims, and justify a final office action.

2. Applicant argues on page 17 that the motivation provided by examiner for modifying Perlman with Wagner, in order to take advantage of higher bandwidth TV channel over a VBI channel is not applicable to applicant's invention because the present invention does not require a high bandwidth. It is pointed out that examiner is only required to provide a reference that modifies the base reference. In response to applicant's argument, the fact that applicant has

recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Examiner points out that, with respect to motivation, to establish a prima facie case of obviousness, first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Thus in a 103 rejection, the motivation (e.g. benefit, advantage, improvement, etc.) for modifying the base reference with the secondary reference, may be the motivation from the base or secondary reference itself. Examiner is not required to modify the base reference with a secondary reference, using the same motivation as the instant application. Applicant states on page 18, "as Wagner would be applied to the applicant's invention". In fact, Wagner is applied to Perlman, and examiner contends that the combination of the two references, along with Collings, reads on the applicant's claims, as recited in light of the amendment of 10/6/2003.

Furthermore, on page 18 applicant specifically argues that Wagner does not teach the claimed feature of the selection of a scan line of a video signal, from claim 17. Applicant argues that Wagner teaches the preemption of entire video channels, instead of a scan line. Examiner respectfully disagrees with applicant's conclusions with respect to Wagner. While it is true that Wagner is enabled to use a full channel for data transmission, the reference also discloses that a

partial TV channel may alternatively be used, see col. 3, lines 50-54. The same passage of Wagner furthermore teaches that a data signal may be inserted in the raster scan lines of a normal TV signal. Even though Wagner later discloses that these raster scan lines may be include VBI lines, the reference does not in any way preclude these raster scan lines not being one or more VBI lines. In fact, Wagner clearly points to using a portion of a TV channel, see col. 7, lines 57-59; col. 8, lines 54-56; col. 9, lines 42-46; col. 10, lines 14-18, col. 10, lines 26-27 & col. 10, lines 38-40). Finally, Wagner states that, "since no video is presently on the channel, the data transmission *may use* all available bandwidth of the channel", emphasis added. The reference does not state that the system "does use" or even that it "generally uses" all available bandwidth, only that it "may use" all available bandwidth.

3. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, on pages 23-24, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

It is clear that Perlman is concerned with selectively inhibiting a TV receiving apparatus form from receiving/displaying unauthorized channels, (Abstract; col. 3, lines 54-60), which is

wholly consistent with the instant invention. However, Perlman only broadly discloses how it transmits the EPG data to a receiver, which includes the authorization information. In particular, Perlman states that as an example, the EPG data may be transmitted over an out-of-band channel, or other conventional data extraction techniques, col. 6, lines 49-57. Wagner is introduced since it is directed to overcoming known problems in conventional data transmission/extraction systems. For instance Wagner teaches that data may be transmitted using one or more protocols, such as VBI, HBI, full video channel, partial video channel, etc. Thus the combination of references of Perlman & Wagner is appropriate, with respect to the transmission of data, such as authorization data.

4. With respect to applicant's discussion of the rejection using Sprague, on page 26, it is generally argued that the number of references is inappropriate. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Applicant further argues that Sprague teaches that the enabling keys are transmitted over the VBI, which is different from the applicant's invention. Examiner points out that Wagner has been cited as teaching transmission data over a normal TV raster scan line, as an alternative to VBI, see col. 3, lines 52-57.

The remaining arguments generally restate the prior discussions of the applicant, and are likewise treated by examiner. The amendments to the claimed filed on 4/20/2004, have not been entered since they provide further limitations.

Any response to this action should be mailed to:

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or faxed to:
(703) 872-9306, (for formal communications intended for entry)
Or:
(703) 746-6861 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399. The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (703) 305-4755. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown

CHRIS GRANT
PRIMARY EXAMINER